Attorney Docket No. 170802-1010

REMARKS / ARGUMENTS

Claims 1-5 are pending, and all claims stand rejected based upon newly cited art. The present Office Action is non-final in that the present Examiner has, at least tacitly, agreed that none of the art previously cited, nor any of the arguments previously made, rendered the present invention, as claimed heretofore, unpatentable.

In this amendment Claim 1 has been amended to further distinguish the present invention from the prior art in two main areas. First, the digital format of the image files has been further defined (as set forth in the specification at page 7, lines 6-8) as being selected from .jpg, .bmp, and .tif files. Further, the amendment clarifies that the unique filename associated with each image file is stored in a database (as set forth in the specification at page 7, lines 8-19).

In the present Office Action claims 1-5 were rejected under 35 U.S.C. 103(a) as being unpatentable over the disclosure contained in U.S. Patent No. 2,494,599 entitled MEANS FOR PHOTOGRAPHICALLY PRODUCING A PLURALITY OF ASSEMBLAGES OF PRESELECTED DATA which issued on January 17, 1950 to J.V. Weckbaugh (herein referred to as "Weckbaugh").

The Examiner stated that Weckbaugh teaches a method for providing personal identification on checks issued by a payor to payees which includes the steps of obtaining an image of each payee by the payor, storing each said image on a storage medium by the payor, selecting payee data for check printing from each payee's data record, and printing checks for each said payee, each of said checks being printed with said payee data, said payee data including each payee's name and the amount of the check, and each said check being printed with an image of the payee, whereby each check will include, in addition to the other

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information, a photographic image of the payee to whom such check was written (Fig. 13, column 1, line 1 thru column 2, line 35, and column 4, line 71 thru column 8, line 75).

The Examiner acknowledged that Weckbaugh teaches the steps of obtaining an image is accomplished by taking a (conventional) photograph using a camera (column 4, lines 71-75), and displaying each payee's social security number on the check (as indicated at Fig. 13, element 107, column 8, lines 73-75).

The Examiner further acknowledged that Weckbaugh does not expressly show the use of a digital camera or a scanner, or the step of storing each of the digital images on a computer medium by using a unique file name (such as a payee's social security number) associated with each payee.

The Examiner took "Official Notice" that the use of a digital camera or a scanner, and the step of storing each of the digital images on a computer medium by using a unique file name (such as a social security number) associated with each person is old and well known in the art. Accordingly, the Examiner took the position that simply using a digital camera or a scanner, and automating the step of storing each of the digital images on a computer medium by using a unique file name gives just what one would expect from the process steps shown in Weckbaugh. Consequently, the Examiner argued that there was no enhancement found in the claimed steps other than the known advantages of using a computer, such as efficiency and the increased speed in processing data and storing and retrieving data and images, and he further argued that the result was the same. Based on the foregoing, the Examiner stated that it was known at the time of the [Applicant's] invention that merely providing an automatic means to replace a manual

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activity which accomplishes the same result is not sufficient to distinguish over the prior art, citing *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Based upon the foregoing, the Examiner concluded that it would have been obvious to a person of ordinary skill in the art at the time of the [Applicant's] invention to use a digital camera or a scanner, and to store each of the digital images on a computer medium by using a unique file name associated with each payee, because this would speed up the process of printing checks, which is purely known, and an expected result from automation of what is known in the art. The Examiner acknowledged that Applicant's invention, "… greatly improves the efficiency of the system by providing an easier way of storing and retrieving data by using a computer, and a user-friendly system."

Claim 1 has been amended to further distinguish the present invention from Weckbaugh. In particular, Weckbaugh teaches the use of a "stack" of photos which are fed (in jackets) into another photographic process to create a final photographic result which the Examiner equates to the present invention, as though no new benefits, other than the automation of a previously known manual system, were obtained. In that regard, the Examiner correctly noted that *In re Venner* held that merely automating a previously known manual system is not patentable. However, the Examiner's reliance upon the holding in *In re Venner* is misplaced for a number of reasons. First, the present invention is not merely an automated version of Weckbaugh, as was the system which the subject of the invention discussed in *In re Venner*. The present invention is a totally different system using totally different technologies and methodologies. While the ultimate result may be similar, the manner of achieving the result is wholly different. Accordingly, the Examiner is reminded that the resultant product is not the

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subject of the present claims, but, rather, the claimed invention relates to a patentable process.

Thus, to the extent that Weckbaugh would be considered relevant, Weckbaugh contains no

teaching which would have enabled one of ordinary skill in the art to carry out the present

inventive method. Weckbaugh taught that the way to select images was to stack existing images,

in jackets, *i.e.*, a sequential ordering of physical items, whereas the present invention relies upon

random access to digitally stored computer images. By way of analogy, if one were to think of

the automating the Weckbaugh process, in the way such automation of known manual processes

was held to be unpatentable in *In re Venner*, one would have to think of something like a

jukebox which had a series of photographs which were mechanically selected and stacked.

Further in the method described by Weckbaugh, a missing image would cause,

not only the resultant document to be wrong, but it would also cause all subsequent documents to

be wrong, as well, due to the sequential nature of the method. Applicant's method, on the other

hand, uses a random access approach, so if an image file was missing or corrupt, it would affect

only that document.

Yet another distinction between Weckbaugh's teaching and Applicant's

invention, is that Weckbaugh taught the creation of a new document from a "paste up" of

existing documents. By analogy, that would be like first printing out the image from the digital

file, then laying it on the check in the proper position, and imaging it again.

While one could go on and on about the differences between the methods,

irrespective of the ultimate desire to produce a check having a photograph of the payee on it, the

relevant points are that Applicant has not simply automated the manual process of Weckbaugh,

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as was the subject of *In re Venner*, but Applicant has, instead, created a wholly new process, which has numerous advantages over the prior art.

Next, the Examiner rejected Claims 1-5 under 35 U.S.C. 103(a) as being unpatentable over the teachings contained in U.S. Patent No. 4,083,635 entitled METHOD OF PRODUCING POSITIVE IDENTIFICATION ON CHECKS which issued on April 11, 1978 to T. K. Reed, Jr. (hereinafter "Reed").

The Examiner took the position that Reed teaches a method for providing personal identification on checks issued by a payor to payees which includes the steps of:

obtaining an image of each payee by the payor, storing each said image on a storage medium by the payor, selecting payee data for check printing from each payee's data record, and printing checks for each said payee, each of said checks being printed with said payee data, said payee data including each payee's name and the amount of the check, and each said check being printed with an image of the payee, whereby each check will include, in addition to the other information, a photographic image of the payee to whom such check was written (Fig. 2, column 3, lines 11-47).

The Examiner acknowledged that Reed does not expressly show the use of a digital camera or scanner, or the step of storing each of the digital images on a computer medium by using a unique file name (such as a payee's social security number) associated with each payee. However, the Examiner took "Official Notice" that the use of a digital camera or a scanner, and the step of storing each of the digital images on a computer medium by using a unique file name (such as a social security number) associated with each person was considered old and well known. The Examiner stated that simply using a digital camera or a scanner, and

storing each of the digital images on a computer medium by using a unique file name would give one just what one would expect from the process steps shown in Reed. In other words, it was the Examiner's position that "...there is no enhancement found in the claimed steps other than the known advantages of using a computer, such as efficiency and the increased speed in processing data and storing and retrieving data and images. The result is the same."

Accordingly, it was that Examiner's position that it would have been obvious to a person of ordinary skill in the art at the time of the invention to use a digital camera or a scanner, and to store each of the digital images on a computer medium by using a unique file name associated with each payee, because this would speed up the process of printing checks, which is purely known, and an expected result from automation of what is known in the art. Further, it was the Examiner's position that the specific steps taught by Applicant, "... greatly improves the efficiency of the system by providing an easier way of storing and retrieving data by using a computer, and a user-friendly system."

As with Weckbaugh, the Examiner's reliance upon Reed is misplaced, as are the Examiner's arguments regarding patentability. In particular, 35 U.S.C. §103 *does not speak of "enhancements"*, it speaks of obviousness based on the teachings in the prior art. The very fact the Examiner acknowledged that Applicant's newly taught, inventive method provides enhancements over the teachings of the cited prior art, namely Weckbaugh and Reed, demonstrates that Applicant's invention is both novel (which was not questioned by the Examiner) and not obvious. After all, why would Reed not have taught an "enhanced" system, had he thought of it, and whether or not he thought of it, he certainly did not provide adequate teachings in his patent.
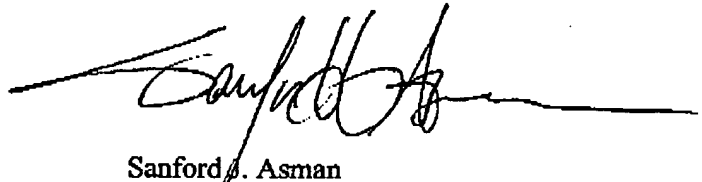
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While in one aspect of his invention Reed teaches the use of "teller checks" in predetermined denominations. These are not produced in any manner remotely similar to the method taught by Applicant. Instead, Reed taught the use of *an office copy machine, blank checks, and an identification card* (See, Abstract and Col. 2, lines 21-39). Interestingly, Reed recognized the problems with a first negotiator trying to "... cash periodic payroll, social security, or welfare checks..." (See, Col 1, lines 20-23), yet Reed did not teach the invention of having the producer (payor) of those checks imprinting them with the photo of the payee, as in the present invention. Instead, Reed teaches placing an identification card on a window of a photocopy machine, and then feeding into the copier "check form sheets" in predetermined denominations (See, Col. 3, lines 21-59).

With respect to Fig. 1, and Col. 3, lines 11-31 of Reed, there is some discussion regarding the use of a computer having stored payee images which would be printed on checks, in a manner similar to that described by the present invention. However, Reed's teachings fail to address several items, including (1) how the images are created and stored (Applicant teaches the use of digital cameras and scanners); (2) what types of image files are used (Applicant teaches .jpg, .bmp, and .tif files); (3) how the files associated with the images relate to the checks as they are being printed (Applicant teaches the use of a unique file name which is associated with the image file using a database). In that the combination of the foregoing items are absent in the teachings of Reed, it cannot be reasonably argued by the Examiner that the present invention, as claimed, would have been obvious from the teachings of Reed.

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In view of the comments herein, along with those previously made of record,

Applicant respectfully contends that the application is allowable, and respectfully solicits

reconsideration and allowance of the claims.

Respectfully submitted,

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